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Robert C. Kowert
Meyertons, Hood, Kivlin, Kowert & Goetzel PC
P. O. Box 398
Austin, TX 78767

TECHNOLOGY CENTER 2100

In re Application of: Lai)
Application No. 10/642,928)
Attorney Docket No. 5681-66300)
Filed: August 18, 2003)
For: Structured Methodology and Design)
Patterns for Web Services)

**DECISION ON PETITION TO
WITHDRAW RESTRICTION
REQUIREMENT UNDER 37 CFR
§1.144**

This is a decision on the petition filed October 20, 2008 under 37 C.F.R. §1.144 and 37 C.F.R. §1.181 to withdraw an outstanding restriction requirement.

The petition is **DENIED**.

RELEVANT PROSECUTION HISTORY

June 29, 2007	A restriction requirement of subcombinations useable together grouping claims 1-17 in one group, claims 18-55 in the second group, claims 56-69, in the third group, and 70-80 in the fourth group.
July 30, 2007	The applicant responded to the restriction requirement, electing group II with traverse and provided some argument supporting the traversal.
Oct 17, 2007	The examiner sent out a non-responsive action response to the applicant's election. The examiner indicated in that action that the applicant's arguments were not persuasive and seemed to indicate that the examiner did not believe that the applicant had elected a group.
Nov 19, 2007	The applicant responded to the examiner's non-responsive amendment action by re-iterating the election and traversal.
Feb 5, 2008	The examiner sent out a non-final rejection based on the applicant's election of group II.

May 5, 2008 The applicant responded to the non-final rejection action with a request for reconsideration.

Aug 19, 2008 The examiner issued a final rejection.

Oct 20, 2008 The applicant filed a notice of appeal along with this petition arguing the restriction requirement.

REGULATIONS AND PRACTICE

37 C.F.R. § 1.144 states:

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested. See 37 CFR § 1.181.

37 C.F.R. § 1.181(f) states:

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

MPEP § 803 states:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)). If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-§806.05(i)); and
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP §803.02, §806.04(a) - §806.04(i), §808.01(a), and §808.02) ... For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP §808.02....

MPEP § 806.05(d) states:

The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. ... Furthermore, restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search.

MPEP § 808.02 states:

Where the * inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

(A) Separate classification thereof: This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) A separate status in the art when they are classifiable together: Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) A different field of search: Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

DECISION

Timeliness

Although the restriction was never made final in accordance with MPEP § 821.01, the initial restriction requirement was maintained in five subsequent communications. To expedite prosecution of this application, the Office action of Feb 5, 2008 which maintained the restriction requirement, is being treated as a Final restriction requirement.

The applicant's petition is timely because it was it was filed before any appeal. *See* 37 CFR §1.144.

Expanded Rationale of Restriction

MPEP 803 provides and sets forth two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; and (B) There must be a serious burden on the examiner if restriction is required.

The restriction requirement made by the examiner satisfied the aforementioned two criteria for a proper requirement for restriction between patentably distinct inventions. *See* Office Action mailed June 29, 2007. It is noticed that the examiner should have provided an expanded reason to support his conclusion. The restriction requirement and the expanded reason to support the examiner's conclusion are provided herewith:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to a web service system which provides web services, where the web service system is implemented using web service architecture, classified in class 709, subclass 203.
- II. Claims 18-55, drawn to a system which generates web service architecture, classified in class 709, subclass 218.
- III. Claims 56-69, drawn to the design and implementation of web service architecture, classified in class 709, subclass 220.
- IV. Claim 70-80, drawn to designing and implementing the security components of web service architecture, classified in class 709, subclass 229.

Inventions I, II, III, and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as generating web service architectures that can be implemented in any type of web service provider system, and is not limited to only be implemented in the Web Service system described in subcombination I. Subcombination III has separate utility of being able to deploy, configure, and implement any type of generated web service architecture to implement it in any type of web service system. The particulars of the process in generating the web service architecture in subcombination II are not required, nor are the particulars required in subcombination I. Subcombination IV has separate utility, such as being able to building and implement security components for any type of web service and web architecture and it not limited to the particulars of the web service architecture disclosed in any of the other subcombinations. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;

- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Distinct Inventions

The applicant argues that the restriction is not proper because the claimed invention overlap in scope. *See* Petition, filed 10-20-08, pg 2-3. This assertion is merely a conclusionary statement and the applicant provides no evidence in support of this assertion. Group I contains one or more mutually exclusive characteristics from Group II, III, and IV such as service requestors and service provider. Group II contains one or more mutually exclusive characteristics from Group I, III, and IV such as generating a high-level architecture for a web services. Group III contains one or more mutually exclusive characteristics from Group I, II, and IV such as translating the one or more use case requirements and one or more technical constraints. Group IV contains one or more mutually exclusive characteristics from Group I, II, and III such as identifying one or more trust domains. The existence of the mutually exclusive elements in the claims supports the idea that the scope of the claims do not overlap. *See* MPEP § 806.05(d). The applicant has provided no arguments to the obviousness of the elements of each claim that do not overlap in the scope so accordingly the claims appear to be distinct.

Separate Utility

The applicant argues that the restriction is not proper because the examiner has failed to show separate utility (*see* Petition, filed 10-20-08, pg 3). The applicant argues that the examiner only shows the subcombinations' utility within the disclosed combination and no separate utility beyond the scope of the combination. The applicant provides no evidence to support any argument that the subcombinations are no separately usable.

The expanded rationale of the restriction provides better explanation of the separate utility of the subcombinations in the invention. The explanation shows that each subcombination has utility in more general implementations of web service architecture and is not limited to the particular requirements of the other subcombinations. Since the scope of the combination defined in the specification of the instant invention relies on the

implement of each of those particulars (for example the mutually exclusive claim limitations), having utility of implementing web service architectures outside of the specific implementations iterated in the other subcombinations provides some utility outside of that scope.

Burden

The applicant argues that the restriction is not proper because the examiner has failed to provide a serious burden (*see* Petition, filed 10-20-08, pg 3-4). The applicant argues that the claims of each group could be classified in alternative subclasses and that the classification of these particular claims to not represent divergent searches (*see* Petition, filed 10-20-08, pg 5-6).

The expanded rationale of the restriction further clarifies the distinction and divergent nature of each of the subcombinations in the application. As proof of serious burden, the examiner must show either A) different classification, B) separate status in the art, or C) divergent field of search. *See* MPEP §808.02. While the subcombinations arguably can be classifiable in the same class and subclass, the restriction clearly indicates that the subcombinations have distinct subject matter (as shown by the mutually exclusive claim elements discussed above) which requires a separate field of search which is not likely to result in finding art pertinent to the other inventions.

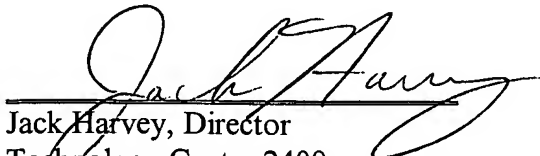
The restriction requirement is hereby maintained.

For the above reasons, the petition is **DENIED**. Further, pursuant to 37 C.F.R. § 1.181(f), the shortened statutory period for reply is continued to run three months from the mailing date of the Final Office Action.

If the petitioner desires further review of this decision, he should file a Request for Reconsideration within two (2) months of the mailing date of this decision. Otherwise, the petitioner may wish to consider filing a petition to seek a review of TC Director's decision.

Any inquiry regarding this decision should be directed the undersigned whose telephone number is (571) 272-4147.

/kb/


Jack Harvey, Director
Technology Center 2400
Network, Multiplexing, Cable and Security